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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/589,049 | 08/10/2006 | Heiko Urtel | 12810-00338-US | 5464 |

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| EXAMINER | |
|---|---|
| PUTTLITZ, KARL J | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1621 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/589,049 | URTEL ET AL. | |
| | Examiner | Art Unit | |
| | KARL J. PUTTLITZ | 1621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 March 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/10/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of 3/5/2009 is noted.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "or rhenium or of rhenium".

In claims 1 the catalyst is closed to rhenium (see "consists of") but is open to on further element (see "comprising"). Therefore, the scope of material making up the catalyst is unclear.

Claim 17 recites "S to 25 carbon atoms".

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 199938824, as evidenced by counterpart U.S. Patent No. 6,355,848 to Antons et al. (Antons).

The rejected claims cover, inter alia, a process for preparing optically active hydroxy-, alkoxy-, amino-, alkyl-, aryl- or chlorine-substituted alcohols or hydroxy carboxylic acids having from 3 to 25 carbon atoms or their acid derivatives or cyclization products by hydrogenating the correspondingly substituted optically active mono- or dicarboxylic acids or their acid derivatives in the presence of a catalyst whose active component consists of rhenium or of rhenium and comprises at least one further element having an atomic number of from 22 to 83, with the provisos that a. the at least one further element having an atomic number of from 22 to 83 is not ruthenium and b. in the case of the preparation of optically active 2-amino-, 2-chloro-, 2-hydroxy- and 2-alkoxy-1-alkanols by catalytically hydrogenating corresponding optically active 2-aminocarboxylic acids, 2-chlorocarboxylic acids, 2-hydroxycarboxylic acids and 2-alkoxycarboxylic acids or their acid derivatives, the at least one further element having an atomic number of from 22 to 83 is not palladium or platinum.

In view of the above embodiments, Antons teaches a process for the preparation of optically active alcohols from optically active carboxylic acids by reducing an optically active carboxylic acid with hydrogen in the presence of a catalyst comprising ruthenium and at least one further metal or transition metal having an atomic number in the range of from 23 to 82, see abstract.

The optically active alcohols are disclosed at columns 1 and 2, for example. Ruthenium/Rhenium catalysts are particularly taught, see paragraph bridging columns 2 and 3, and example 1. Supported catalysts are also taught, see column 3, lines 15+.

Claims 1, 5 and 7-17 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 2004022522, as evidenced by U.S. patent No. 7,217,847 to Fischer et al. (Fischer).

Fischer teaches a process for preparing optically active 2-amino-, 2-chloro-, 2-hydroxy- or 2-alkoxy-1-alcohols by catalytically hydrogenating appropriate optically active 2-amino-, 2-chloro-, 2-hydroxy- and 2-alkoxycarboxylic acids or their acid derivatives in the presence of catalysts comprising palladium and rhenium or platinum and rhenium.

The optically active alcohols are given at columns 2-4.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5 and 7-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-12 of copending Application No. 10/534457. Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims cover a process for hydrogenating with a catalyst that overlaps the catalyst of the instant invention in a manner rendering the instant process prima facie obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/513040 Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims cover a process for hydrogenating with a catalyst that overlaps the catalyst of the instant invention in a manner rendering the instant process prima facie obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-17 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6831182. Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims cover a process for hydrogenating with a catalyst that overlaps the catalyst of the instant invention in a manner rendering the instant process prima facie obvious.

## ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at telephone number (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karl J. Puttlitz/

Primary Examiner, Art Unit 1621